

Doc Code: AP.PRE.REQ

PTO/SB/SS (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

03-1075

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on October 23, 2006

Signature

Typed or printed

name Joseph A. Herndon

Application Number

10/729,123

Filed

December 5, 2003

First Named Inventor

Schluetter

Art Unit

2173

Examiner

Namitha Pillai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.Registration number 50,469☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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Telephone number

October 23, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 03-1075)

IN THE APPLICATION OF:)	
Schluetter et al.)	
)	
Serial No. 10/729,123)	Examiner: Namitha Pillai
)	
Filed: 12/05/2003)	Group Art Unit: 2173
)	
Title: Method and System For)	
Displaying a Cursor on a)	
Trading Screen)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiners:

In response to the Advisory Action of August 23, 2006, Applicants respectfully request review of the rejections of Claims 1-18. The following remarks are based on those presented in Applicants' Response of April 6, 2006 ("Response 1") and Response of August 2, 2006 ("Response 2").

REMARKS

Applicants submit that a prima facie case of obviousness has not been shown because (1) there is no motivation or suggestion to combine the references, (2) even if the references were combined, the combination does not show all of the claimed limitations, and (3) the proposed modifications would change the fundamental principle of operation/intended purpose of the prior art. Applicants have addressed all three arguments in the previous responses.¹ However, in this brief, Applicants will show that the rejection cannot stand even when looking at (3) alone.

I. Overview of the Invention

To assist Examiners with review of the claims, Applicants respectfully present some background and an illustrative example of the presently claimed invention. Applicants also respectfully request Examiners to refer to the application as filed for a more complete understanding of different aspects of the claimed invention.

¹ Response 1, p. 8, 3rd full paragraph-p. 9, 2nd full paragraph, Response 2, p. 11, Section III; Response 2, p. 9-10, Section II; Response 2, p. 6-9, Section I.

The trading screens of FIGs. 2 and 3 display market data such that the inside market (best bid/ask prices) is displayed near the center of the screen, and each change of the inside market results

FIG. 2 is a trading screen with a table of market data. The table has four columns: E/W, Bid, Ask, and Prc. A cursor is positioned at the Ask price of 143. The data is as follows:

E/W	Bid	Ask	Prc
		15	145
			144
	35		143
	100		142
	75		141
20			140
125			139
			138
20			137

Prior Art
FIG. 2

FIG. 3 is a trading screen similar to FIG. 2, but the market data has shifted. The cursor is now at the Ask price of 145. The data is as follows:

E/W	Bid	Ask	Prc
		10	147
			146
	25		145
	15		144
			143
35			142
			141
20			140
125			139
			138
			137

Prior Art
FIG. 3

in the dynamic update of the displayed prices to maintain the inside market near the center of the screen. FIG. 2 shows a cursor resting at a price of 143. FIG. 3 shows the same screen, only that the market conditions have quickly changed such that the inside market has moved up in price. The display updated, but the cursor did not move. Now, the cursor is resting at a price of 145 rather than 143. Using the illustrated trading screen, if a trader were to select the price of

143 in FIG. 2 as the display was in the process of updating, and the trader did not move the cursor during the quick update, the trader would send an order at a price of 145 rather than 143.

FIGs. 6 and 7 illustrate an example operation of the claimed invention. FIG. 6 shows a cursor resting at a price of 143. FIG. 7 shows the same screen, except some time later when the inside market

prices changed and the display has been updated, such that the price of 143 has moved to a different location.

According to the claimed invention, the cursor is automatically moved to a second location along with the corresponding market information. Using the illustrated trading screen, if a trader were to select the price of '143' in FIG. 6 as the display was in the process of updating, the trader would send an order at a desired price of 143.

FIG. 6 is a trading screen with a table of market data. The table has four columns: E/W, Bid, Ask, and Prc. A cursor is positioned at the Ask price of 143. The data is as follows:

E/W	Bid	Ask	Prc
		15	145
			144
	35		143
	100		142
	75		141
20			140
125			139
			138
20			137

FIG. 6

FIG. 7 is a trading screen similar to FIG. 6, but the market data has shifted. The cursor is now at the Ask price of 143. The data is as follows:

E/W	Bid	Ask	Prc
		10	147
			146
	25		145
	15		144
			143
35			142
			141
20			140
125			139
			138
			137

FIG. 7

Independent Claims 1, 13, and 18 reflect the features described above.² Selecting a price, however, is not required by the independent Claims 1, 13, and 18.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner's rejection³ included independent claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over US Application 2002/0120551 to Jones ("Jones") in view of US 5,598,183 to Robertson ("Robertson").

In response to the advisory action, Applicants were not looking at the references individually as Examiner suggests.⁴ Applicants agree with Examiner that one cannot show nonobviousness by

² Response 2, pages 2, 3, and 4.

³ Final Office Action of 7/5/2006, p. 2.

⁴ Advisory Action of 8/23/2006.

attacking references individually when the rejection is based on a combination.⁵ Applicants have showed in prior responses that the combination does not teach all of the claimed limitations.⁶ Applicants have also showed that the motivation to combine is lacking.⁷ Additionally, Applicants showed that when the prior art is modified, as proposed by Examiner, the principle operation of Robertson changes significantly.⁸ Applicants previously noted that according to MPEP 2143 VI “if the modification or combination of the prior art would change the principle operation of *the prior art being modified*, then the teachings of the *references* are not sufficient to render the claims *prima facie* obvious,” (emphasis added).⁹ Additionally, selectively removing a step from a reference without the suggestion to do so amounts to classic hindsight reconstruction of the claims, and such practice is explicitly prohibited by MPEP Section 2141.01. While the required modification would change the principle operation of Robertson and such a change is sufficient to overcome the obviousness rejection on its own, Applicants will show that the required modification would also change the principle operation of Jones. Thus, Applicants respectfully submit that the obviousness rejection cannot stand.

III. The modification changes the principle operation of Robertson and Jones thus vitiating the obviousness rejection based on the combination of the references per MPEP 2143 VI

Jones relates to a visual-kinesthetic system for trading securities. Jones discloses using a stylus to set various order parameters, including a price.¹⁰ For example, to set a price parameter, a stylus is used to select a price along an axis. Jones states that it is simple to set a desired price using its disclosed system.¹¹ As set forth in the previous response, Jones does not disclose automatically moving a cursor as called for by Claim 1, much less provides a motivation or suggestion to modify its own system to include such a limitation.¹²

Examiner uses Jones to disclose “receiving a signal, and in response to the signal, updating the display region, where the display region is updated by the moving chart and changes in chart data.”¹³ Examiner further asserts “Jones does not disclose automatically moving the cursor to a second location associated with the first portion of market information, the cursor being moved together with the first

⁵ Advisory Action of 8/23/2006.

⁶ Response 2, p. 9-10, Section II.

⁷ Response 2, p. 8, last full paragraph – p. 9; and Response 2, p. 10, first full paragraph.

⁸ See, e.g., Response 2, p. 6-9, Response 1, p. 8, first full paragraph.

⁹ Response 2, p. 6.

¹⁰ Figures 5A-5D of Jones, Response 1, p. 6.

¹¹ Jones, paragraph 39, Response 2, p. 10, paragraph 1. For instance, Jones states “...the trader can simply touch the plot of moving stock prices at a desired position to indicate an order The invention allows the user to do this simply and graphically with a minimum of data entry input from a keyboard.

¹² Response 2, p. 10.

¹³ Office Action of July 5, 2006, p. 3.

portion of market information.”¹⁴ Examiner turns to Robertson to support what Jones is lacking, namely “automatically moving the cursor to a second location associated with the first portion of market information.”¹⁵ Examiner then asserts that it would have been obvious to modify Robertson.¹⁶ While Applicants disagree that it would be obvious to modify Robertson, the proposed modification would change the principle operation of Robertson in more than one way, and thus each change, separately, would vitiate the obviousness rejection based on the combination of the references per MPEP 2143 VI.¹⁷

Robertson teaches a process that assists a user in navigation through the menus of a display. First, Robertson requires a step of selecting to initiate the process of determining where the cursor should be placed next. For example, selecting CLOSE as shown in FIG. 3C in Robertson causes the process to analyze the control list and determine where to place the cursor next (function YES in FIG. 3D).¹⁸ Thus, the step of selecting is one of the key elements in both Robertson and Jones. In Jones, the step of selecting presets a price parameter for an order, as Jones discloses no other way to set a price using the stylus. In Robertson, the step of selecting initiates the process of moving the cursor to a new location. Thus, the step of selecting cannot be removed from either Jones or Robertson, and to remove it results in violation of MPEP 2141.01 and 2143 VI.

Applicants respectfully submit that if Robertson was applied to Jones as proposed by Examiner, the combination would not result in the claimed invention, as the combination would require a selection first, and the selection would result in setting a price per Jones, which would still result in the problem identified in FIGs. 2 and 3. As both prior art references require a selection, Jones to preset a price for an order and Robertson to move a cursor, the combination would result in nothing more than (1) possibly selecting a wrong price as the price could change during the process of updating the display while the selection was being made, and (2) per Robertson, upon detecting the selection, moving the cursor to a different function. Where the cursor would be moved calls for a lot of speculation, but the movement would not cure selecting the wrong price.

Additionally, the principle operation of Robertson requires moving the cursor to a location associated with information that is different from the information associated with the cursor’s previous location. FIGs. 3A-3D in Robertson clearly show this. According to FIG. 3A, upon selecting the FILE button, the cursor is moved to the NEW button.¹⁹ Similarly, according to FIG. 3C, upon

¹⁴ Id.

¹⁵ Office Action mailed on 7/5/2006, p. 3.

¹⁶ Office Action mailed on 7/5/2006, p. 3.

¹⁷ Response 2, p. 6.

¹⁸ See, Robertson FIGs. 3C and 3D, and Response 2, pages 7-8.

¹⁹ See, Response 2, p. 6-7 for additional discussion.

selecting the CLOSE button, the cursor is moved to the YES button.²⁰ However, according to the claimed invention, when the cursor is moved, the information with which the cursor is associated does not change. Thus, the modification of Robertson to follow this aspect of the claimed invention would also change the principle operation of Robertson, and such a modification would vitiate the obviousness rejection.

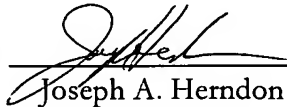
As Applicants have shown, the necessary modifications required to arrive at the Applicants' claimed invention would change the principle operation of both references. Additionally, the selective removal of steps from the references would amount to the classic hindsight reconstruction of the claims. Accordingly, per MPEP 2143 VI and 2141.01, the obviousness rejection cannot stand.

Conclusion

All the claimed limitations must be taught or suggested by the prior art to establish prima facie obviousness. Applicants respectfully submit that Robertson/Jones combination still does not teach, at minimum, the limitation of Claim 1 that calls for "...automatically moving the cursor to a *second location associated with the first portion* of market information..." (Emphasis added). So, not only does the combination lack this limitation, there is no motivation for the modifications to make the combination operative. And, if such modifications were made, as explained above and in the previous responses, it would result in changing the principle operation of the prior art, thus vitiating the obviousness rejection based on the combination of the references per MPEP 2143 VI. Claims 1, 13, and 18 share similar limitations. Applicants' dependent claims are patentable for distinct reasons; however, each are patentable as they depend from either Claim 1, 13, or 18. Applicants submit that the present application is in condition for allowance and notice to that effect is hereby requested.

Respectfully submitted,

Date: 10/23/06

By: 
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²⁰ Id.